

REMARKS

The Office Action mailed December 8, 2003 has been received and carefully considered. Upon entry of the present amendment, claims 12-13 and 15-16 will be pending.

Claims 12-13 and 15-16 stand rejected as assertedly indefinite under 35 U.S.C. § 112, second paragraph and stand rejected under 35 U.S.C. § 102(b) or In the alternative under 35 U.S.C. § 103(a) as obvious over JP 61-171732 in the name of Unitaka ("Unitaka"). Claims 12-13 and 15-16 also stand rejected under 35 U.S.C. § 103(a) as obvious over WO 98/47940 to Loontjens et al. ("Loontjens"). Finally, the Examiner has rejected the claims under the judicially created doctrine of obviousness-type double patenting over claims 6-11 of commonly owned U.S. Patent 6,504,004.

I. Amendments to the Claims

Claim 12 has been amended to more particularly describe the Applicant's invention. In particular, the claim has been amended to describe that the diamine and triamine units in the polymer chains are independent of the polyamide repeating units to alleviate any confusion that the claim as previously drafted may have been meant to include a monomer segment of a particular polyamide repeating unit.

Furthermore, the term "functional" has been removed as a modifier of the amine units. Applicant notes that the specification is clear that "functional" refers to incorporating a compound into the polymer chain that modifies the properties of the polymer chain from the properties that would be present were the compound not incorporated into the chain. Nevertheless, to avoid any possible confusion that the term is meant only to refer to substituent groups, the limitation has been removed from the claims.

II. Rejection under 35 U.S.C. § 112

In light of the claims as amended, it is respectfully submitted that all but one of the Examiner's rejections under 35 U.S.C. § 112 have been obviated. With respect to the single remaining rejection under § 112, the Examiner asserts that the phrase "polyamide repeating units" reads on the "bis-N-acyl bislactam moieties." Office Action at page 3. This rejection is respectfully traversed.

A bislactam, by definition, does in fact have more than one amide group; but this is clearly not a "polyamide" as embraced by Applicant's claimed invention. By contrast, a "polyamide repeating unit" is commonly understood as a repeating unit of a polymer which is a polyamide. The repeating unit may, for example, be derived from a single monomer with both an acid and an amine end or from a combination of

two monomers, such as a diacid and diamine to form one repeating unit. One of ordinary skill in the art would easily distinguish between a single compound that has more than one amide group and a repeating unit of a polymer. Thus, claim 12 is not indefinite and the rejection should be withdrawn.

III. Prior Art Rejections

The rejections in view of the prior art should be withdrawn as the cited references neither anticipate nor render obvious the claimed invention. The Examiner indicated at pages 5 and 6 of the Office Action that the rejections of claims 12 and 13 with respect to both Unitaka and Loontjens were based on the premise that the amine units of the polymer chain in Applicant's claimed invention read on the polyamide repeating units of that same polymer chain. In light of the preceding amendment to claim 12 which clarifies that both polyamide repeating units and at least one diamine and triamine units are independently present in the polymer chain, the basis for the Examiner's rejection has been removed and therefore the rejection should be withdrawn. As claims 15-16 now depend from claim 12, the rejections to claims 15-16 should also be withdrawn.

IV. Double Patenting Rejection

The Examiner has rejected the claims under the judicially created doctrine of obviousness-type double patenting in view of U.S. Patent 6,504,004 (the '004 Patent). Applicant respectfully traverses this rejection. Applicant respectfully submits that the claims as amended overcome the double-patenting rejection by clarifying that the polymer chain independently comprises both polyamide repeating units and at least one of diamine and triamine units which is not obvious in view of the teaching of the '004 Patent.

For at least the reasons stated above, claims 12-13 and 15-16 are in condition for allowance. Accordingly, Applicant respectfully requests that the amendments be entered and the Application be allowed and passed to issue. In the event any outstanding issues remain, Applicant would appreciate the courtesy of a telephone call to Applicant's undersigned representative to resolve such issues in an expeditious manner.

In view of the foregoing, allowance of the above-referenced application is respectfully requested.

Respectfully submitted,



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